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STATUS OF CLAIMS

Claims 1-23 are presently pending and under examination.

REMARKS

Rejection Under 35 U.S.C. § 102(b)

In the Office Action, the Examiner rejected claims 1-23 as being anticipated by Lafontaine et al. (U.S. Pat. No. 5,665,103).

In response, Applicants respectfully traverse the rejection and their accompanying remarks. Lafontaine et al. does not teach the invention of the claims. For a reference to anticipate a claim it must disclose each and every element of the claim. *See* MPEP 2131 and cases cited therein, *especially Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) and *In re Marshall*, 578 F.2d 301, 304, 198 USPQ 344, 346 (Fed. Cir. 1978). The Lafontaine reference fails as an anticipatory reference because it fails to teach all of the claimed elements of the present invention.

The present device of independent claim 1 is directed to a medical device delivery sheath comprising an active member that volumetrically expands and contracts, said active member further comprising an electroactive polymer.

Lafontaine et al. fails to teach the invention of the claims. Lafontaine et al. fails to disclose a delivery sheath comprising an active member comprising an electroactive polymer or an active member that volumetrically expands and contracts. The Examiner, for example, asserts that "Lafontaine et al. discloses the claimed invention in figures 1, 4, and 6, an annular electroactive polymer sheath (25,42) comprises a plurality of active (26a,26b) (see col. 6, lines 23-57)." (Paragraph 2 of the Office Action).

However, reviewing the figures and passages cited by the Examiner in detail, reference numbers 26a and 26b refer to *electrodes* for determining the position of the stent and do *not* refer to the claimed "active member further comprising an electroactive polymer." There is simply no disclosure of a medical device delivery sheath having an active member comprising an electroactive polymer.

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This is not surprising, given that Lafontaine et al. teaches an entirely different device. That is, Lafontaine et al. discloses a stent locating device which locates a metallic stent within a body "by detecting an electrical parameter affected by the position of the stent relative to the position of the locating device. The electrical parameter may be detected with a pair of electrodes or a coil mounted to the distal end of the stent locator." (Lafontaine et al., col. 2, lines 2-19). The stent locating device has an "outer sheath 25 [which] includes a single pair of electrodes 26a and 26b, but may also include two or more pairs. Proximal and distal electrodes 26a and 26b electrically communicate with the stent locating circuitry 60 by way of insulated electrical leads 27a, 27b and flexible cord 61." (Col. 6, lines 36-40). These *electrodes* of Lafontaine et al. simply do not meet the claim element of an *active member comprising an electroactive polymer*. Indeed, there is no teaching or suggestion in Lafontaine et al. that these electrodes are equivalent to any hint that they are anything more than "electrodes" to "electrically communicate with the stent locating circuitry 60." (Col. 6, lines 36-39). The Examiner has not shown otherwise.

The Examiner asserts that an "annular electroactive polymer sheath" is indicated by reference numbers 25, 42 of Lafontaine et al. and that "a plurality of active [sic]" is indicated by reference numbers 26a and 26b of Lafontaine et al. However, Applicant respectfully indicates that such is not the case. Reference numbers 25 and 42 refer to an "outer sheath 25 [that] may be made of polyimide by conventional methods." (Col. 6, lines 47-48). Reference numbers 26a and 26b refer to "proximal and distal electrodes 26a and 26b [that] may be made by plating a conductive metal such as silver or gold onto the exterior of the sheath 25 and etching away the unneeded portions of the coating." (Col. 6, lines 48-51). Thus, there is no evidence that the device of Lafontaine et al. inherently meets the claimed limitation: active member that volumetrically expands and contracts, said active member further comprising an electroactive polymer.

A holding of inherency must flow as a necessary conclusion from the prior art, not simply a possible one. The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because

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art is not sufficient to establish the inherency of that result or characteristic. *In re Rijkkaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 U.S.P.Q. 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted); MPEP 2112 IV.

Applicant asserts that the Examiner has not met his burden and requests that he reconsider and withdraw the rejection under 35 U.S.C. 102(b).

Claim 1 is an independent claim, and the above comments apply directly to them. All other rejected claims are dependent directly on claim 1, and the rejection of those claims fails at least because of the fundamental defect discussed above.

CONCLUSION

Applicants submit Claims 1-23 are in condition for allowance, early notification of which is earnestly solicited. Should the Examiner be of the view that an interview would expedite consideration of this Amendment or of the application at large, request is made that the Examiner telephone the Applicants' attorney at (908) 518-7700 in order that any outstanding issues be resolved.

FEES

The Examiner is authorized to charge the petition fee for a two-month extension of time

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of four hundred and fifty dollars (\$450) and any other fees deemed to be owing for this application to Deposit Account Number 50-1047.

Respectfully submitted,



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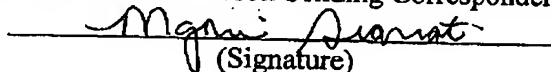
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